



Remarks

The above-captioned application was filed to provoke an interference with U.S. Patent No. 5,553,852 to Higuchi. Previously, all claims, i.e. claims 1-8, were rejected under 35 U.S.C. § 112, first paragraph. After appeal to the Board of Patent Appeals and Interferences, the Board reversed the Examiner and remanded the present application for further consideration. In this regard, the Board indicated that "each specific limitation which the examiner has found to lack proper support in the originally filed specification appears to find proper support in the originally filed claims which are part of the originally filed specification".

In the May 28 Action and after remand, the Examiner withdrew the finality of the rejection from the last Office Action. However, the Examiner maintained the rejection of claims 1-8 under 35 U.S.C. § 112, first paragraph. Specifically, the Examiner now contends that the parent application, U.S. Application 08/070,510 from which Applicant claims priority for the claimed subject matter in this application, does not enable the claimed subject matter. Specifically, the Examiner has asserted the following:

1. In claim 1, the lower limit on the core diameter (29 mm), the upper limit on the core specific gravity (1.4), the lower limit of the intermediate layer thickness (1 mm), the upper limit of the specific gravity of the intermediate layer (1.2), the lower limit of the hardness of the intermediate layer (85 on JIS C), and the upper limit of the thickness range of the cover being claimed (3 mm) are not enabled.

As an example the upper limit on the thickness range of the originally disclosed cover was 1.27 mm.

2. In claim 3, there is no basis provided for the applicant's reasoning that the now claimed hardness range of the cores and covers was inherent in the original disclosure. Without a basis in the original disclosure the now claimed ranges must be considered non-enabled.

3. In claim 5, the lower limit of the diameter of the center core being claimed (29 mm) was not disclosed in the original disclosure. The lower limit originally disclosed was 35.052 mm.

4. In claim 6, neither the upper or lower limit of the claimed difference in the specific gravity (.5 - .1) was disclosed in the original disclosure. By applicant's admission the limits of the difference disclosed were (.234 - .164).

5. In claim 7, neither the upper limit (1.0) nor the lower limit (.9) were disclosed in the original disclosure. While values within that range were disclosed they do not make inherent the upper and lower bounds of the claimed range.

6. In claim 8, neither the upper limit (100) nor the lower limit (85) were disclosed in the original disclosure. While values within that range were disclosed they do not make inherent the upper and lower bounds of the claimed range.

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The enablement requirement of 35 U.S.C. §112, first paragraph requires that the specification describe the invention such that one skilled in the art is able to make and use the claimed invention as broadly as it is claimed. *In re Cortright*, 49 USPQ2d 1464 (Fed. Cir. 1999). The statute has been interpreted to require that the "specification adequately disclose[s] to one skilled in the art how to make...or carry out, the claimed invention without undue experimentation." *Process Control Corp. v. Hydrexclaim Corp.*, 52 USPQ2d 1029 (Fed. Cir. 1999). Thus, the test of enablement is not whether experimentation is necessary, but whether such experimentation is unduly extensive. *National Recovery Technologies, Inc. v. Magnetic Separation Systems, Inc.*, 49 USPQ2d 1671 (Fed. Cir. 1999). "The test for undue experimentation is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction of how to practice a desired embodiment of the claimed invention." *Johns Hopkins University v. Cellpro Inc.*, 47 USPQ2d 1705 (Fed. Cir. 1998).

The MPEP recognizes the fact that the enablement requirement does not require the disclosure of every species in a claimed genus. "For a claimed genus, representative examples together with a statement applicable to the genus as a whole will ordinarily be sufficient if one skilled in the art (in view of the level of skill, state of the art and the information in the specification) would expect the claimed genus could be used in that manner without undue experimentation." MPEP, §2164.02 (8th ed.).

When rejecting a claim for lack of enablement, the PTO bears the initial burden of setting forth a reasonable basis as to why the scope of the claims is not enabled by the specification. *In re Wright*, supra. In making such a rejection, **the PTO must identify what information is missing and supply specific technical reasons why one skilled in the art could not supply this information without undue experimentation.** MPEP, §2164.04 (8th ed.). "**In examining a patent application, the PTO is required to assume that the specification complies with the enablement provision of Section 112 unless it has 'acceptable evidence or reasoning' to suggest otherwise...**[T]he PTO thus must provide reasons supported by the record as a whole why the

specification is nonenabling...[T]hen and only then does the burden shift to the applicant to show that one or ordinary skill in the art could have practiced the claimed invention without undue experimentation." *Gould v. Mossinghoff*, 229 USPQ 1, 13-14 (D. D.C. 1985), aff'd in part, vacated in part, and remanded sub nom, *Gould v. Quigg*, 3 USPQ2d 1302 (Fed. Cir. 1987) (emphasis added).

With all due respect, it is submitted that the Examiner has not satisfied the burden of setting forth a reasonable basis as to why the scope of the claims is not enabled by the specification of the parent '510 application. Specifically, the Office has not supplied specific technical reasons why one skilled in the art could not supply the alleged missing information without undue experimentation. The Examiner is reminded that "the PTO is required to assume that the specification complies with the enablement provision of Section 112 unless it has 'acceptable evidence or reasoning' to suggest otherwise." No evidence or reasoning has been provided.

Although certain ranges that are recited in the pending claims are not literally duplicated in the '510 specification, many values within the claimed ranges are set forth. Furthermore, many upper and/or lower limits are described for the various claimed parameters. The Board itself even stated that each of the claim terms at issue appears to find proper support. Applicant submits that the claimed subject matter, including all of the disputed ranges, could be carried out without undue experimentation. The Office is required, according to the MPEP, to assume that the specification is sufficiently enabling unless it has acceptable evidence or reasoning to suggest otherwise. Furthermore, the Office must supply specific technical reasons why one skilled in the art could not supply the allegedly missing information without undue experimentation. The Office has not done so.

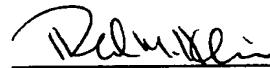
In view of the foregoing, it is respectfully urged that all pending claims, claims 1-8, do in fact meet the requirements of 35 U.S.C. § 112, and specifically, the enablement requirement of that statute.

The Examiner then also rejected the pending claims based on 35 U.S.C. § 102 as being anticipated by the '852 patent to Higuchi. Upon withdrawal of the § 112 rejection, and support being provided by the noted parent application, this ground of rejection is moot.

In view of the foregoing, all pending claims 1-8 are submitted to be in condition for allowance.

Respectfully submitted,

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